

REMARKS

In the Office Action that was mailed on August 1, 2003, claims 1, 2, 8, 9, 15, and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kaply (U.S. Patent No. 6,215,490) ("Kaply"), Robert Cowart, Mastering Windows 3.1 Special Edition ("Cowart"), and Baker et al. (U.S. Patent No. 5,210,689) ("Baker"); and claims 3-7, 10-14, and 17-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kaply, Cowart, and Baker in view of Ludolph (U.S. Patent No. 5,874,958) ("Ludolph"). The foregoing rejections are respectfully traversed.

Claims 1-24 are pending in the subject application, of which claims 1, 8, and 15 are independent claims.

Amendments to the Claims:

Claims 1, 8, and 15 are amended herein to change the term "manipulation" to "continuous uninterrupted activation." Care has been exercised to avoid the introduction of new matter. Support for the amendments to claims 1, 8, and 15 may be found in the Specification at page 10, lines 14-17 and at page 14, lines 29-31.

Rejections of the Claims:

Independent claims 1, 8, and 15 of the present invention (as amended herein) recite (using the language of claims 8 and 15 as an example) "changing a display on a display unit, from a first display region of a display image to a second display region of the display image that is different from the first display region, by a scrolling process in response to a continuous, uninterrupted activation of an input device or key; and automatically returning the display to said first display region in response to a cancellation of the scrolling process wherein the cancellation corresponds to a release of the input device or key."

On page 4 of the Office Action, the examiner states that Kaply and Cowart do not teach cancellation corresponding to the release of an input device or key, but cites Baker as disclosing the same in Figure 5c. However, Baker applies to text and symbol entry (Baker, Abstract) as opposed to display scrolling. Further, Figure 5c of Baker focuses on the state of a

delete selection key, which functions as an undo key to undo a previous action. (Baker, col. 20, lines 14-18). In fact, Baker expressly applies only to a dedicated key (or at best, a key having another function in addition) and an affirmative, separate, complete keystroke (pressing and releasing) to undo (delete) any unwanted text or symbol entry. (Baker, col. 21, lines 3-13).

Baker does not disclose or suggest canceling a scrolling process when an input device or key is released. In Baker, at least two complete press-and-release actions are required to undo any unwanted text or symbol entry, i.e., a first complete keystroke to enter the text (e.g., pressing and releasing the keyboard key marked "G") and a second complete keystroke to delete the character (e.g., pressing and releasing the "Delete" or "Backspace" key). In contrast, the present invention recites a single action, i.e., the activation and release of an input device or key.

Further, the Applicants note that Kaply basically corresponds to the conventional information processing apparatus that is discussed in the Specification at page 1, line 36 to page 2, line 11. Kaply requires the troublesome operation of manually returning to the certain page by manipulating the widget control 216a/b as illustrated in Figure 5B. In addition, Cowart requires the user to separately operate the mouse in order to return the display region back to the original display region. Therefore, both Kaply and Cowart fail to disclose or suggest automatically returning the display in response to a cancellation of the scrolling process, wherein the cancellation corresponds to the release of an input device or key.

In addition, the Applicants note that the examiner did not even attempt to supply the motivation to combine Baker with Kaply and Cowart. MPEP § 706.02(j) requires that, "[t]o establish a *prima facie* case of obviousness [under § 103,] ... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." (emphasis in original). Therefore, the examiner has not presented a *prima facie* case of obviousness due to the failure to properly discuss the motivation to combine the references.

As a courtesy to the examiner, the Applicants respectfully remind the examiner of the current standard for establishing the motivation to combine the references. MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is

proper." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The Applicants respectfully call the examiner's attention to the fact that all of the following cases are outdated in light of the cases discussed above: In re Fine, In re Jones, Wang Labs. v. Toshiba Corp., Cable Electric Products v. Genmark, In re Sheckler, In re Bode, In re Jacoby, In re Bozek, and In re Prater. The Applicants note that the examiner's reliance on such older case law would be in error, and the Applicants respectfully request that the examiner review the case law cited by the Applicants above prior to making a determination on the issue.

In addition, the Applicants respectfully assert that someone of ordinary skill in the art would not have been motivated to combine Kaply and Baker because Kaply discusses display scrolling and Baker discusses text and symbol entry. Specifically, scrolling is usually begun and maintained by a continuous, uninterrupted activation of a key (usually an arrow key) or input device (usually a mouse), and cancellation thereof is usually accomplished by the release of the key or input device. However, text/symbol entry involves multiple, repeated, and distinct keystrokes. (Baker, col. 25, lines 63-68).

Therefore, independent claims 1, 8, and 15 of the subject application (as amended herein) are patentably distinguishable over the cited references. In addition, dependent claims 2-7, 9-14, and 16-24 are allowable based in part on their dependency, directly or indirectly, from one of independent claims 1, 8, and 15.

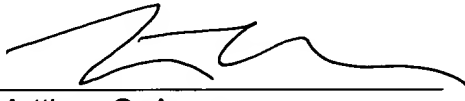
Withdrawal of the foregoing rejections is respectfully requested.

There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal matters remaining after this response, the examiner is requested to telephone the undersigned to attend to these matters. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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